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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,462	01/13/2000	Per S. Andersen	0459-0391P	7006

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Birch Stewart Kolasch & Birch LLP
P O Box 747
Falls Church, VA 22040-0747

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,462

Applicant(s)

ANDERSEN ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 April 2003 has been entered.

Response to Arguments

2. Applicant's arguments filed on 16 April 2003 have been fully considered but they are not persuasive. An explanation is given in para. 18-21 below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 26 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claims 26 and 45, element "(a)" is new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26, 38 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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At claims 26 and 45, element "(a)" is indefinite. ("Entry" is a process, while responses, etc., are results.)

At claim 38 line 3, "the SYSIWTG editor" lacks antecedent basis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-50 are rejected under 35 U.S.C. 103(a) as obvious over by Witek et al. in view of NEXPO '97.
9. Witek et al. teaches (independent claims 1, 19, 25 and 44) a system and method for advertisement sales and management, the system comprising (Fig. 1) data storage and database means 20, retrieval means 14, processing means 16 and 26, and a number of workstations (computer terminals 22), one or more being adapted to entering advertisement orders (col. 5 lines 28-31), the database and data processing means being adapted to store and manage data relating to an advertising customer (user), order, medium or media, schedule, contents and presentation elements (col. 5 lines 28-31; col. 56 lines 8-10; col. 48 line 14; col. 46 lines 7-9; and col. 42 lines 10-16); defining the advertisement on the basis of entered order data (col. 8 lines 60-61); the system and method thereby supporting entry, sale and management of ads in several media (col. 56 lines 8-10) based on entry of a single advertising order.
10. Witek et al. does not teach entry, sale and management of several related ads based on entry of a single advertisement order. NEXPO '97 teaches reusing content (pp. 27 of 40, first full para.), which reads on entry, sale and management of several related pieces of content based on entry of a single piece of content. Because ads, as the source of the bulk of publishing revenue, are important content, and because this convenience would reduce cost and encourage advertising sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of

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Witek et al, so as to provide a single system supporting entry, sale and management of several related advertisements in several publications/media based on entry of a single advertisement order.

11. Witek et al. also teaches claims 2-5, 7, 9, 20-22, 27-30, 32, 34 and 46-48 at the locations indicated above. Witek et al. also teaches: (claims 11, 12, 36 and 37) that the customer agrees with the price of the ad, determined dynamically at the time of the order (col. 56 lines 25-31); (claims 14, 15, 39 and 40) the Internet (title); and (claims 16, 17, 41 and 42) a GUI related to a target media (Fig. 8-10, description beginning at col. 23 line 44).
12. Witek et al. does not teach (claims 23 and 49) editing and re-storing the ad contents and presentation elements. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the NEXPO '97 teaching of content reuse. As evidence tending to show inherency, it is noted that ads are generally not identical from one publication to the next, requiring some sizing or other editing, and would accordingly have to be re-stored in order to be reused.
13. Witek et al. does not teach the presentation element limitations of claims 6 and 31, but since the reference does teach formatting the presentation for the user (col. 42 lines 15-16), at least some of these presentation element limitations must be inherent. That is, formatting necessarily requires that the ad have a size, that the printed ad have a typeface or font, etc.
14. Witek et al. does not teach (claims 8 and 33) that the physical presentation of the ad is established on the basis of data relating to contents. NEXPO '97 teaches observing content-related restrictions (pp. 13 of 40, last full para.), which reads on establishing the physical presentation of the ad on the basis of data relating to contents. Because advertisers would be very displeased if content-related restrictions were not maintained, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al.
15. Witek et al. does not teach (claims 10 and 35) determining price of the ad based on attributes associated the ad. However, the reference does teach presenting the user with rate information (col. 56 line 26). Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to determine price of an ad based on attributes such as its size or colors. Because it is efficient to accept common or standard practices, it

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would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine the price of the ad based on attributes associated the ad.

16. Witek et al. does not teach (claims 18 and 43) modifying the GUI without modifying binary code. The reference invention uses GUI for the user menus (Fig. 8-10, description beginning at col. 23 line 44). Because these menus differ for each participating newspaper (col. 6 lines 22-23) and can be expected to require frequent changes, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modifying the GUI without modifying binary code.
17. Witek et al. does not teach (claims 13, 24, 38 and 50) a WYSIWYG editor. Because it is ideal for modifying the user menus (para. 12 above), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide a WYSIWYG editor.
18. Reply to Applicant's arguments (pp. 20-25) – "QUARK" is hereby made of record to address applicant's arguments. This document supports the teachings of NEXPO '97 (para. 6 above), that QPS 2.0 "lets text or pictures in one layout be reused in multiple layouts across different publications" (top of p. 2/2, as marked).
19. Applicant argues (pp. 20-21) that NEXPO '97 teaches accessing rather than outputting to multiple publications, but "reuse" reads on outputting. Applicant also argues that NEXPO '97 reads on multiple publications not multiple media ("several media" in the claims), but later acknowledges (p. 21 middle) that Witek et al. teaches two media (para. 5 above, col. 56 lines 8-10 in the reference). Two media reads on "several media" (Merriam-Webster's Collegiate Dictionary).
20. Applicant argues (p. 23) that the motivation to combine the references, explained in the last action as "... the economic incentive to reduce costs and expand sales", pertains potentially to all businesses. That is true. The remainder of applicant's economic reasoning in pp. 23-24 is based on arguable assumptions.
21. Applicant's example explanation of Witek et al. in the center of p. 24 is correct, but it should be noted that the rejection is based on the combination of two references, not merely on Witek et al. Applicant's explanation of the instant invention "CCI system" on pp. 24-25 does appear to be different from the reference invention (Witek et al. plus NEXPO '97) in suggesting material for "a range of products" as a single input. However, examiner could

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not find this feature disclosed in the original application, and "product" is not defined in the specification, so it is not clear that the "range of products" distinction is patentable, especially from the current application.

Conclusion

22. This is a continuation of applicant's earlier Application No. 09/482,462. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
25. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

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26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
27. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter. In this particular case, since applicant has once filed an RCE and examiner has once searched the specification for allowable matter, the prospects do not appear to be good that another CPA or RCE could be successful.
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
Art Unit 3622

15 May 2003